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Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

On January 6, 2003

READEMENT

TOWNSEND and TOWNSEND and CREW LLP

Niddle M. Wartell

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Thomas Cech et al.

Application No.: 09/766,253

Filed: January 19, 2001

For: NOVEL TELOMERASE

Examiner: Carla J. Myers

Art Unit: 1634

INFORMATION DISCLOSURE

STATEMENT UNDER 37 CFR §1.97 and

Attorney Docket No.: 015389-002921US

Client Reference No.: 018/180C

§1.98

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

The references cited on attached form PTO/SB/08A and PTO/SB/08B are being called to the attention of the Examiner. In accordance with 37 CFR §1.98(d), copies of some of the references listed on PTO/SB/08A and PTO/SB/08B can be found in U.S. Application No. 08/846,017, filed 04/25/1997 (Attorney Docket No. 015389-002920US). All other references are enclosed herewith.

Applicants also wish to make the Examiner aware of the following co-pending patent applications:

- 1. U.S. Patent App. No. 09/432,503, filed 11-02-1999, Applicant Cech et al., Attorney Docket No. 015389-0002611US;
- 2. U.S. Patent App. No. 09/721,477, filed 11-22-2000, Applicant Cech et al., Attorney Docket No. 015389-002914US;

Cech et al. PATENT

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3. U.S. Patent App. No. 09/721,506, filed 11-22-2000, Applicant Cech et al., Attorney Docket No. 015389-002916US; and

4. U.S. Patent App. No. 09/974,584, filed 11-19-1997, Applicant Cech et al., Attorney Docket No. 015389-002950US.

To comply with 37 CFR §1.98(a)(2)(iii), the specifications, drawings and currently pending claims for U.S. Application No. 09/432,503 (Attorney Docket No. 015389-002611US) and U.S. Application No. 09/974,584 (Attorney Docket No. 015389-002950) are enclosed. The currently pending claims from U.S. Application Nos. 09/721,477 (Attorney Docket No. 015389-002614US) and 09/721,506 (Attorney Docket No. 015389-002616US) are also enclosed; copies of the specification and drawings for these latter two applications are not enclosed because these applications are the same as US Application No. 09/432,503.

It is respectfully requested that the cited references be expressly considered during the prosecution of this application, and the references be made of record therein and appear among the "references cited" on any patent to issue therefrom.

As provided for by 37 CFR 1.97(g) and (h), no inference should be made that the information and references cited are prior art merely because they are in this statement and no representation is being made that a search has been conducted or that this statement encompasses all the possible relevant information.

Applicant believes that no fee is required for submission of this statement. However, if a fee is required, the Commissioner is authorized to deduct such fee from the undersigned's Deposit Account No. 20-1430. Please deduct any additional fees from, or credit any overpayment to, the above-noted Deposit Account.

Respectfully submitted,

Scott L. Ausenhus Reg. No. 42,271

TOWNSEND and TOWNSEND and CREW LLP Two Embarcadero Center, 8th Floor San Francisco, California 94111-3834

Tel: 303-571-4000 Fax: 303-571-4321 SLA:nmb 60036116 v1 JAN 0 8 2004 W

Substitute for form 1449A/PTO

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(use as many sheets as necessary)

Sheet | 1 | of | 12

	Complete if Known
Application Number	09/766,253
Filing Date	January 19, 2001
First Named Inventor	Thomas Cech
Art Unit	1634
Examiner Name	Carla J. Myers
Attorney Docket Number	015389-002921US

	U.S. PATENT DOCUMENTS+						
		Document Number	D.46	Name of B	Daniel Calvana IV		
Examiner Initials*	Cite No. ¹	Number Kind Code ² (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear		
	A1	US-3,817,837	06-18-1974	Tanenholtz et al.			
	A2	US-3,850,752	11-26-1974	Schuurs et al.			
	A3	US-3,939,350	02-17-1976	Kronick et al.			
	A4	US-3,996,345	12-01-1976	Ullman et al.			
<u> </u>	A5	US-4,275,149	06-23-1981	Litman et al.			
	A6	US-4,277,437	07-07-1981	Maggio			
	A7	US-4,366,241	12-28-1982	Tom et al.			
	A8	US-4,683,195	07-28-1987	Mullis et al.			
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	A15	US-5,747,317	05-05-1998	Cao			
	A16	US-5,770,422	06-23-1998	Collins			
	A17	US-5,917,025	06-29-1999	Collins			
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	A38	US 2003-0059787 A1	03-27-2003	Cech et al.			
	A39	US 2003-0096344 A1	05-22-2003	Cech et al.			
	A40	US 2003-0100093 A1	05-29-2003	Cech et al.			
	A41	US Application No. 09/432,503		Cech et al.			

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PTO/SB/08A (08-03) 2004 Substitute for form 1449A/PTO Complete if Known 09/766,253 **Application Number** INFORMATION DISCLOSURE Filing Date January 19, 2001 STATEMENT BY APPLICANT First Named Inventor Thomas Cech Art Unit 1634 (use as many sheets as necessary) **Examiner Name** Carla J. Myers 2 Sheet 12 Attorney Docket Number 015389-002921US

	U.S. PATENT DOCUMENTS+					
		Document Number				
Examiner Initials*	Cite No.1	Number Kind Code ² (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	
	A42	U.S. Application No. 09/721,477		Cech et al.	-	
Ì	A43	U.S. Application No. 09/721,506		Cech et al.		
	A44	U.S. Application No. 90/974,584		Cech et al.		

	FOREIGN PATENT DOCUMENTS							
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	レ B1	GB	2317891	Α	04-08-1998			
i	B2	JP	9154575	A2	06-17-1997			\boxtimes
υ	B3	PCT	WO 84/03564	A1	09-13-1984			
V	B4	PCT	WO 93/23572	A1	11-25-1993			
ý	B5	PCT	WO 94/17210	A1	08-04-1994			
7	B6	PCT	WO 95/13382	A1	05-18-1995			
ι	₽ В7	PCT	WO 96/01835	A1	01-25-1996			
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9	B9	PCT	WO 96/19580	A2	06-27-1996			
V	B10	PCT	WO 96/40868	A1	12-19-1996			
ı)	B11	PCT	WO 98/01542	A1	01-15-1998			
U	B12	PCT	WO 98/01543	A1_	01-15-1998			
J	B13	PCT	WO 98/07838	A1	02-26-1998			\boxtimes
J	B14	PCT	WO 98/08938	A1	03-05-1998			X
V	B15	PCT	WO 98/14592	A2	04-09-1998			
٧	B16	PCT	WO 98/14593	A2	04-09-1998			
1	B17	PCT	WO 98/21343	A1	05-22-1998			
ý	B18	PCT	WO 98/23759	A2	06-04-1998			
J	B19	PCT	WO 98/37181	A2	08-27-1998			
- /	B20	PCT	WO 98/45450	A1	10-15-1998			
1	B21	PCT	WO 98/59040	A2	12-30-1998			
Å	B22	PCT	WO 99/01560	A1	01-14-1999			
·J	B23	PCT	WO 99/33998	A2	07-08-1999			
1	B24	PCT	WO 99/38964	A2	08-05-1999			
,	B25	PCT	WO 00/46355	A2	08-10-2000			

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Sheet 3 of 12

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Application Number	09/766,253				
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Art Unit	1634				
Examiner Name	Carla J. Myers				
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		NON PATENT LITERATURE DOCUMENTS	
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L	C1	ADAMSON, D. et al. "Significant Telomere Shortening in Childhood Leukemia", Cancer Genet. Cytogenet, 1992; pp. 204-206, Vol. 61	
Ü	C2	ANDERSON and YOUNG, "Quantitative Filter Hybridization" in Nucleic Acid Hybridization, 1985, pp. 73-111	
Ų	C3	AUSUBEL et al., Current Protocols in Molecular Biology, 1989, John Wiley & Sons, New York NY	
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,	C5	AUTEXIER, CHANTAL, et al., "Telomerase and cancer: revisiting the telomere hypothesis; Trends in Biochemical Sciences, 1996, pp. 387-391, Vol. 10, No. 21.	
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V	C9	BERGER and KIMMEL (Eds), "Guide to Molecular Cloning Techniques", Methods in Enzymology, 1987, vol. 152, Academic Press, San Diego CA	
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V	C11	BITTER, G. et al., "Expression and secretion vectors for yeast," <i>Methods in Enzymology</i> , 1987, pp. 516-544, Vol. 153, Academic Press, Inc.	
1	C12	BLACKBURN and CHIOU, "Non-nucleosomal packaging of a tandemly repeated DNA sequence at termini of extrachromosomal DNA coding for rRNA in Tetrahymena," Proc. Natl. Acad. Sci., 1981, pp. 2263, Vol. 78	
ν	C13	BLACKBURN and GALL, " A tandemly repeated sequence at the termini of the extrachromosomal ribosomal RNA genes in Tetrahymena, " J. Mol. Biol., 1978, pp. 33, Vol. 120	
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1	C15	BRADFORD, "A Rapid and Sensitive Method for the Quantitation of Microgram Quantities of Protein Utilizing the Principle of Protein-Dye Binding," Anal. Biochem., 1976. pp. 248, Vol. 72	
1	C16	BRAUNSTEIN et al., "Transcriptional silencing in yeast is associated with reduced nucleosome acetylation," Genes Develop., 1993, pp. 592, Vol. 7	
i	C17	CALVIO et al., "Identification of hnRNP P2 as TLS/FUS using electrospray mass spectrometry," RNA, 1995, pp. 724, Vol. 1	

Examiner	Date	
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PTO/SB/08B (08-03) n 1449B/PTO Complete if Known Application Number 09/766,253 ORMATION DISCLOSURE Filing Date January 19, 2001 First Named Inventor Thomas Cech Art Unit 1634 (use as many sheets as necessary) Examiner Name Carla J. Myers of 12 Attorney Docket Number 015389-002921US Sheet 4

		NON PATENT LITERATURE DOCUMENTS	
Examiner Initials *	Cite No.1	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
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ν	C19	CHAN and TYE, "Organization of DNA sequences and replication origins at yeat telomeres, " Cell, 1983. p. 563, Vol. 33	
i	C20	CHIU, et al. "Replicative senescence and cell immortality: the role of telomeres and telomerase", <i>Proc. Soc. Exp. Bio. Med.</i> , 1997, p. 99, Vol. 214.	
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i	C22	COLBERE-GARAPIN et al., "A new dominant hybrid selective marker for higher eukaryotic cells," J. Mol. Biol., July 1981, pp. 1-14, Vol. 150, No. 1	
v	C23	COLE et al., "The EBV-hybridoma technique and its application to human lung cancer," Monoclonal Antibodies and Cancer Therapy, 1985, pp. 77-96, Alan R. Liss Inc., New York NY.	
1	C24	COLEMAN HEALY, K. "Telomere dynamics and telomerase activation in tumor progression: prospects for prognosis and therapy" <i>Oncol. Res.</i> , 1995, pp. 121-130, Vol. 7	
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ν	C28	COOMBS, Dictionary of Biotechnology, 1994, Stockton Press, New York NY	
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J	C30	COUNTER et al., "The catalytic subunit of yeast telomerase," Proc. Natl. Acad. Sci. U.S.A., 1997, 9202-9207, Vol. 94.	
V	C31	COUNTER et al.; "Telomerase Activity in Normal Leukocytes and in Hematological Malignancies"; Blood; May 1, 1995; pp. 2315-2320, Vol. 85	
V	C32	COUNTER et al.; "Telomere shortening associated with chromosome instability is arrested in immortal cells which express telomerase activity" <i>The EMBO Journal</i> ; 1992; Vol. 11; No. 5, pp. 1921-1929	
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1	C34	CREIGHTON, T. Proteins, Structures and Molecular Principles, 1983, WH Freeman and Co, New York, NY	

Examiner	Date
Signature	Considered

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

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Sheet 5 of 12

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Application Number	09/766,253				
Filing Date	January 19, 2001				
First Named Inventor	Thomas Cech				
Art Unit	1634				
Examiner Name	Carla J. Myers				
Attorney Docket Number	015389-002921US				

		NON PATENT LITERATURE DOCUMENTS	
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V	C36	DIEFFENBACH and DVEKSLER, PCR Primer, a Laboratory Manual, 1995, Cold Spring Harbor Press, Plainview NY	
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7	C45	Genbank Accession No. L38903 (ZAHNER et al.) July 26, 1996	
IJ	C46	Genbank Accession No. Q06163 (DU, Z.) 1995	
V	C47	Genbank Accession No. S39696 (GLASER et al.) 1993	
7	C48	Genbank Accession No. S53396, (DU, Z.) 1995	
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,	C50	GenBank, EST Database, Accession No. W70315, (HILLIER, et al.) October 17, 1996	
1	C51	Genome Issue of <i>Science</i> , 1994, pp. 1981-2144, Vol.265.	

Examiner	Date	
Signature	Considered	

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STATEMENT BY APPLICANT (use as many sheets as necessary)

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Sheet

of 12

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Attorney Docket Number	015389-002921US	

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Examiner Initials *	Cite No. ¹	(book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	Т,
v	C52	GILLEY, D. et al., "Altering specific telomerase RNA template residues affects active site function," Genes Develop., 1995, pp. 2214-2226, Vol. 9, Cold Spring Harbor Laboratory Press.	
1	C53	GLASER, P. et al. "Bacillus subtilis genome project: cloning and sequencing of the 97 kb region from 325° to 333°" <i>Molecular Microbiology</i> , 1993, pp. 371-384, Vol. 10, No. 2.	
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i	C57	GRAY, J.T. et al., "Cloning and expression of genes for the Oxytricha telomere-binding protein specific subunit interactions in the telomeric complex," Cell, 1991, pp.807-814, Vol. 67.	
V	C58	GREENWOOD, S. et al., "Phylogenetic relationships within the class oligohymenophorea, phylum ciliophora, inferred from the complete small subunit rRNA gene sequences of Colpidium campylum, Glaucoma chattoni, and Opisthonecta henneguyi," J. Mol. Evol., 1991, pp. 163-174, Vol. 33	
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IJ	C60	GREIDER, C. "Telomere Length Regulation," Ann. Rev. Biochem., 1996, pp. 337-365, Vol. 65, Cold Springs Harbor Laboratory Press, New York.	
./	C61	GREIDER, C. "Telomeres, Telomerase and Senescence"; BioEssays; 1990; pp. 363-369, Vol. 12, No. 8.	
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7	C63	GREIDER, C. and BLACKBURN, E. "Identification of a specific telomere terminal transferase activity in Tetrahymena extracts," Cell, Dec. 1985, 405-413, Vol. 43	
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Examiner	Date
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WIFORMATION DISCLOSURE STATEMENT BY APPLICANT

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Sheet of | 12

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Examiner Name	Carla J. Myers	
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